

U.S. Patent Application Serial No. 10/648,700
Reply to Office Action dated January 10, 2006

Remarks:

Applicant has read and considered the Office Action dated January 10, 2006 and the references cited therein. Claims 1 and 2 have been amended and new claims 8-11 have been added. Claims 1-11 are pending.

Applicant thanks the Examiner for the time and courtesy extended in meeting and granting an interview on March 30, 2006, with inventor, Dr. Yvan Fortin, Applicant's Representative, Louis-Pierre Gravelle and an expert witness, Dr. Richard Sullivan.

During the interview, agreement with respect to the claims was not reached, but changes to the claims to include the features of structural relationship between the connecting bar and the meso-bar, and between the meso-bar and the iso-bar were discussed. As agreed, during the interview, the present response is being submitted incorporating discussed changes, and some changes not discussed, for further consideration.

Claims 1-4 have been rejected under Section 102(b) as being anticipated by the NARDI reference, U.S. Patent No. 5,221,206, while claims 5-7 have been rejected under Section 103(a) as being unpatentable over NARDI.

Under 35 U.S.C. 102, the Examiner bears the burden of presenting a *prima facie* case of anticipation. In *W. L. GORE & ASSOCS. v. GARLOCK INC.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); the Federal Circuit stated that "anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration" at 220 USPQ 313. In other words, anticipation requires a specific disclosure of the claimed invention. Furthermore, it has been held by the Supreme Court that if the invention is an article of manufacture, then for the prior art to be anticipatory, it must disclose the article as opposed to a process that might create such an article. The Supreme Court has further stated in *COHN v. UNITED STATES CORSET CORP.*, 93 U.S. (3 Otto) 366, 377 (1876): "The plaintiff

U.S. Patent Application Serial No. 10/648,700
Reply to Office Action dated January 10, 2006

claims a manufacture, not a mode of making it; and the important inquiry, therefore, is, whether the prior publication described the article ... What is required is a description of the thing patented, not of the steps necessarily antecedent to its production."

As was demonstrated during the interview, Figure 1 of NARDI is an intermediate figure of the "final product" of NARDI, which is illustrated in Figure 2. If one studies Figure 2 and performs a careful reading of NARDI, Applicant asserts that the Action does not make a *prima facie* case of anticipation using this reference.

As explained during the interview, reference numeral 6 in NARDI has been characterized as an iso-bar, and reference numeral 7 in NARDI has been considered as a meso-bar. Once the NARDI article is manufactured, bar 6 is not removably fastened to bar 7. In fact, it is the fused assembly of bars 6 and 7 which is removably attached to bar 2.

Applicant has made modifications to the claims and asserts that the claims overcome the §102 rejection and patentably distinguish over NARDI and the art of record.

Specifically, the mating bar has been recited as standard which patentably distinguishes from NARDI. Specifically, NARDI at column 4, line 7 and following states: "In fact, it is not necessary, in this case, to produce a refractory duplicate of the piece to be modeled, but the work is done on the elements which constitute the fixed part of the prosthesis, which are obtained beforehand in a conventional manner, using appropriate portions of the calcinable auxiliary bars." This implies that each prosthesis of NARDI is customized and does not come in standard sizes and therefore teaches away from the present invention.

The pair of mating bars has further been characterized in that each has a fore part and two opposite rear ends, which clearly NARDI does not teach.

Finally, the iso-bar and the meso-bar have been characterized as being complementary to each other. In the context of the present invention, the usual dictionary definition of

U.S. Patent Application Serial No. 10/648,700
Reply to Office Action dated January 10, 2006

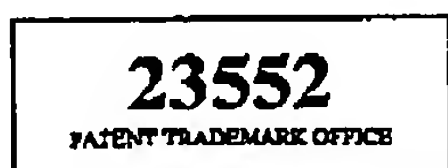
"complementary" is to be used, and one such definition is taken from the Oxford Dictionary, Thesaurus and Word Guide, copyright 2001, Oxford University Press, where it is stated: "complementary: adjective; 1. combining so as to form a complete whole or to enhance each other. 2. relating to complementary medicine."

Clearly, definition 2 is inapplicable in the present case. Here, the pair of mating bars are complementary to each other as they combine so as to form a complete whole.

This is clearly not taught or suggested by NARDI. Applicant asserts that claim 1 patentably distinguishes over NARDI. Claims 2-7 also distinguish over NARDI for the same reasons and others.

New independent claim 8 is a kit claim, which corresponds to the language of the pair of standard mating bars recited in claim 1. Applicant asserts that claim 8 also distinguishes over NARDI for at least the same reasons discussed above. Claims 9-11 depending from claim 8 also patentably distinguish over NARDI for at least these reasons and others.


It is thus respectfully submitted that the claims on file are allowable over the prior art of record. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicant's representative at 612.336.4728.



Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903
612/332-5300

Date: 4/10/06


Gregory A. Sebald
Reg. No. 33,280
GAS/km